REMARKS/ARGUMENTS

In the Office Action mailed November 13, 2008, claims 1-3 and 5-12 were rejected. In response, Applicant hereby requests reconsideration of the application in view of the below-provided remarks and Request for Continued Examination (RCE), which is filed herewith. No claims are amended, added, or canceled.

Claim Rejections under 35 U.S.C. 103

Claims 1-3, 5-7, and 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kodim (U.S. Pat. No. 7,005,940, hereinafter Kodim) in view of Block et al. (U.S. Pat. No. 7,343,137, hereinafter Block). Additionally, claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kodim in view of Block and further in view of Phillips et al. (U.S. Pat. No. 6,765,536, hereinafter Phillips). Additionally, claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kodim in view of Block and further in view of Fukamachi et al. (U.S. Pat. Pub. No. 2004/0266278, hereinafter Fukamachi).

However, Applicant respectfully submits that these claims are patentable over Kodim, Block, Phillips, and Fukamachi for the reasons provided below.

Independent Claim 1

Claim 1 is patentable over the combination of Kodim and Block because the combination does not teach all of the limitations of the claim. Additionally, the combination of Kodim and Block is improper because the proposed modification of Kodim would change the principle of operation of Kodim. Claim 1 recites:

> Antenna switch (31) which is arranged to alternately operate in a receive mode and a transmit mode, the antenna switch comprising an adaptive filter (30) for coupling a signal processing means to an antenna (1) during the receive mode and for electrically insulating the signal processing means from the antenna (1) during the transmit mode, wherein the adaptive filter (30) has a first passband (22,24) during the transmit mode and a second passband (20) during the receive mode, wherein the first passband (22, 24) is a band-pass passband.

Claim 1 (emphasis added).

1. Kodim and Block do not teach a band-pass passband during the transmit mode.

Claim 1 recites a filter having a first passband during the transmit mode that is a band-pass passband. The present Office Action acknowledges that Kodim does not specifically disclose the first passband is a band-pass passband. Hence, the Office Action states that "Block et al. disclose a protective device 6, which is implemented as a band-pass filter as disclosed in fig. 1 and further disclosed in col. 4 lines 36-37." The Office Action does not assert, however, that the band-pass filter of Block is operable "during the transmit mode," as recited in claim 1.

Block describes "band-pass filters 15, 16, 17 which are connected to the signal outputs 3." Block, col. 5, lines 46-47. Block further discloses that "The signal outputs are electrically connected to receiver amplifiers 19a through the band-pass filters 15, 16, 17." Id., lines 57-59 (emphasis added). Block further describes that the "signals supplied by the transmitter amplifiers 19 are filtered by the low-pass filters 13, 14." Id. col. 5, line 67, to col. 6, line 1 (emphasis added). In other words, the band pass filters in Block are operable only during the receive mode, and only low-pass filters operate during the transmit mode. Block does not teach a filter having a band-pass passband during the transmit mode.

Neither Kodim nor Block teach a filter having band-pass passband during the transmit mode, as recited in the claim. Consequently, the combination of Kodim and Block does not teach all the limitations of the claim. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because the combination of Kodim and Block does not teach all of the limitations of the claim.

2. The proposed modification of Kodim to include a band-pass filter having a passband is improper.

Even if the combination of Kodim and Block were to teach all of the limitations of the claim, the proposed combination of Kodim and Block is nevertheless improper because the proposed modification of Kodim would change the principle of operation of Kodim.

The Final Office Action proposes modifying Kodim to include a first passband that is a band-pass passband.

> Kodim does not specifically disclose the first passband is a band-pass passband.
>
> Block et. al. disclose a protective device 6 which is implemented as a band-pass filter as disclosed in fig. 1 and further disclosed in col. 4, lines 36-37.
>
> Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the multiband transformation stage 14 of Kodim to include a protective device as disclosed by Block et al.
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> Final Office Action, page 4.

By varying the effective length of the transmission lines, the multiband transformation stage of Kodim blocks the transmission frequency from reaching the receiver. As stated in Kodim, the use of the transmission lines has the effect that "the low-power stage 16 remains isolated from the high power stage 12 and the antenna port 22." Kodim, column 8, lines 42-44 (emphasis added). In other words, the transmission lines T1 and T2 of Kodim operate to form a band-stop or notch filter, not a band-pass filter having a band-pass passband.

Modifying the transformation stage of Kodim to operate as a band-pass filter would change the principle of operation of Kodim. Consequently, such a modification does not form a proper basis for a rejection under 35 U.S.C. 103(a).

The M.P.E.P. states that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. 2143.01 VI (emphasis added). As an example of such "a change in the basic principle under which the [primary reference] construction was designed to operate," the M.P.E.P. describes that a device designed for rigidity could not be modified to form a rejection of a device designed for resiliency. M.P.E.P. 2143.01(VI), citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, the multiband transformation stage in Kodim operates as a band-stop filter that blocks the transmission frequency. Modifying Kodim to include a transformation stage having a band-pass filter that passes only frequencies within a band

would be a change to the basic principle under which Kodim was designed to operate. Indeed, it would be a change to the exact opposite of the design of Kodim, because the transmission lines in Kodim are designed as a band-stop filter rather than a band-pass filter.

Much as a change from a rigid design to a resilient design represents a change in the basic principle of operation of the device of In re Ratti, in this case, a change from a filter that blocks a range of frequencies to a filter that passes a range of frequencies is clearly a change in the basic principle of operation of Kodim. Consequently, the modification of Kodim proposed by the Office Action is not proper to render claim 1 *prima facie* obvious. As a result, Applicant submits that claim 1 is patentable over the proposed combination of Kodim and Block because Kodim cannot properly be modified to use a band-pass passband.

Dependent Claims

Claims 2-3 and 5-12 depend from and incorporate all of the limitations of independent claim 1. Applicant respectfully asserts claims 2-3 and 5-12 are allowable based on an allowable base claim. Additionally, each of claims 2-3 and 5-12 may be allowable for further reasons.

CONCLUSION

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

/mark a. wilson/

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Mark A. Wilson
Reg. No. 43,994

Wilson & Ham
PMB: 348
2530 Berryessa Road
San Jose, CA 95132
Phone: (925) 249-1300
Fax: (925) 249-0111